

## **REMARKS**

### **Administrative Overview**

Claims 1-48 were presented for examination. Claims 49-71 were withdrawn from consideration by Applicants' election with traversal to the restriction requirement made on May 4, 2004. Applicants note with appreciation the Examiner's allowance of claims 30-48, and the Examiner's indication of allowable subject matter in claims 1-7, 10-16, 18-20, and 26-29. Claims 1-7, 10-16, 18-20, and 26-29 were rejected but are allowable if amended to overcome the rejections under 35 U.S.C. §112, second paragraph. Claims 8 and 9 were objected to as depending upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 17 and 21-25 were rejected.

In the current amendment, claims 1, 3, 11, 17, 21, 27, and 29 are amended. No new matter has been introduced. Upon entry of the current amendment, claims 1-48 will be pending in this application, of which claims 1, 17, 21, and 30 are independent. Applicants submit that pending claims 1-48 are in condition for allowance.

The following comments address all stated grounds of rejection. Applicants urge the Examiner to pass the claims to allowance in view of the remarks set forth below.

### **Information Disclosure Statements**

The Examiner indicates the receipt of duplicate Information Disclosure Statements of May 4, 2004 and May 6, 2004. Applicants submitted a First Supplemental Information Disclosure Statement on May 4, 2004, and also provided a duplicate courtesy copy of the First Supplemental Information Disclosure Statement in the Response to the Restriction Requirement also submitted on May 4, 2004. The Examiner indicates that the May 4, 2004 copy of the Information Disclosure Statement is being ignored, and the May 6, 2004 copy was considered.

The Examiner indicates that the Information Disclosure Statements of September 8, 2000, and May 6, 2004 have been fully considered except for item CG in the Information Disclosure Statement of September 8, 2000, and items B10 and B12 in the First Supplemental Information Disclosure Statement of May 4, 2004. Specifically, the Examiner indicates that item CG was illegible, and that items B10 and B12 were not provided in English.

Applicants are separately submitting a Second Supplemental Information Disclosure Statement today via first class mail and enclose herein a courtesy copy of the Information Disclosure Statement for the Examiner. Applicants include in the Second Supplemental Information Disclosure Statement copies of documents for items B10, B12, and CG addressing the issues noted by the Examiner.

#### Specification Amendments

The Examiner objected to the abstract of the disclosure because it is not a single paragraph in accordance with MPEP §608.01(b). Applicants hereby amend the abstract into a single paragraph. No new matter has been introduced.

#### Claim Amendments

Claims 1, 3, 11, 17, 21, 27, and 29 have been amended to clarify and more fully appreciate the Applicants' claimed invention. Support for the amended claims can be found on page 8, line 16 to page 9, line 16; Figure 1; and throughout the remainder of the specification. No new matter has been introduced. Applicants submit that the presently pending claims are in condition for allowance.

**Claim Rejections Under 35 U.S.C. §112, Second Paragraph****I. Claims 1-7 and 10-20 Rejected Under 35 U.S.C §112, second paragraph**

Claims 1, 11, and 17 were rejected under 35 U.S.C. §112, second paragraph, as incomplete for omitting essential steps. Dependent claims 2-7, 10, 12-16, and 18-20 were rejected because they depend from rejected claims 1, 11, and 17. Applicants respectfully traverse this rejection.

Applicants hereby amend claims 1, 11, and 17, and submit that claims 1, 11, and 17 are not missing any unclaimed critical features. Claims 2-7 and 10-16 depend on and incorporate the patentable subject matter of independent claim 1. Claims 18-20 depend on and incorporate the patentable subject matter of independent claim 17. Thus, claims 2-7, 10-16, and 18-20 are not missing any unclaimed critical features. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the Examiner's rejection of claims 1-7 and 10-20 under 35 U.S.C. §112, second paragraph.

**II. Claims 21-29 Rejected Under 35 U.S.C §112, second paragraph**

Claims 21, 27, and 29 were rejected under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regards as their invention. Dependent claims 22-26 and 28 were rejected because they depend from rejected claim 21. Applicants respectfully traverse this rejection.

Applicants hereby amend claims 21, 27, and 29, and submit that claims 21, 27, and 29, as amended, particularly point out and distinctly claim the invention. Claims 22-26 and 28 depend on and incorporate the patentable subject matter of amended claim 21. As such, claims 22-26 particularly point out and distinctly claim the subject matter to which the Applicants regard as their invention. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the Examiner's rejection of claims 21-29 under 35 U.S.C. §112, second paragraph.

**Claim Rejections Under 35 U.S.C. §102**

III. Claims 17, 21-23 and 25 Rejected Under 35 U.S.C §102 As Anticipated By Ross

Claims 17, 21-23 and 25 were rejected under 35 U.S.C. §102 as anticipated by U.S. Patent No. 5,553,139 to Ross et al. (“Ross I”), and U.S. Patent No. 5,553,143 to Ross et al. (“Ross II”) (collectively “Ross”). Claims 17 and 21 are independent claims. Claims 22-23 and 25 are dependent on and incorporate the patentable subject matter of independent claim 21. Applicants respectfully traverse this rejection and submit that Ross fails to disclose each and every element recited in claims 17, 21-23 and 25, as amended.

A. Independent Claim 17

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Independent claim 17 is directed towards a method for authenticating a third device to a first device. Amended claim 17 recites encrypting a first key with a second key by a first device and *transmitting by the first device the encrypted first key to the third device*. The first device encrypts the second key with a third key and *transmits the encrypted second key to a second device*. The second device decrypts the encrypted second key in response to receiving the third key from the first device. The third device decrypts the encrypted first key using the second key obtained from the second device.

Ross does not disclose *a first device transmitting the encrypted first key to the third device, and transmitting the encrypted second key to the second device*. Instead, Ross describes the enforcement and management of software licenses. In Ross, the software licenses are created and encrypted at the software manufacturer and shipped separately from the product to a reseller to put in a license database. Resellers are provided reseller passwords by the software manufacturer to decrypt the licenses from the license database and provide the licenses to

installers of the product. In other cases, the product is shipped with a disabled license to the end user and an enabler key is provided to the installer to enable the license. The license or the enabler key may be obtained by the installer from a reseller, agent or the manufacturer and may be provided via phone or mailed to the installer. The installer uses the enabler key to enable the license or use the provided license information to install the software product. Once the license is installed, a policy manager as part of the software product can manage and enforce licenses for software on a network.

Although Ross discusses providing encrypted licenses to resellers and end users, Ross does not discuss transmitting the license encrypted with a second key from a first device to a second device, and transmitting from the first device the second key encrypted by a third key to a third device. As such and in contrast to the claimed invention, Ross does not disclose *a first device transmitting the encrypted first key to the third device, and transmitting the encrypted second key to the second device.*

Because Ross fails to disclose receiving *a first device transmitting the encrypted first key to the third device, and transmitting the encrypted second key to the second device*, Applicants respectfully request the Examiner to reconsider and withdraw the Examiner's rejection of claim 17 under 35 U.S.C. §102.

B. Independent Claim 21

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Independent claim 21 is directed towards a method for authenticating a third device to a first device. Amended claim 21 recites *transmitting by the first device a first message to the third device, and a second message to a second device. The second device transmits a second key of the second message to the third device*, which obtains a first key of the first message using the second key.

Ross does not disclose *transmitting by the first device a second message to the second device, and the second device transmitting a second key of the second message to a third device*. Instead, Ross describes methods for software licensing and enforcement. Ross distributes encrypted license keys to resellers to provide installers licenses to install the software. The reseller decrypts the encrypted licenses using a reseller password and provides installers via phone or by mail a license for installing the software product. Ross also distributes to end users encrypted licenses with the product, and the end users obtain an enabler key to unlock the license to use the software. Ross does not discuss sending the encrypted license in a message from a first device to a second device, and the second device sending the license from the message to a third device. As such and in contrast to the claimed invention, Ross does not disclose *transmitting by the first device a second message to the second device, and the second device transmitting a second key of the second message to a third device*.

Because Ross fails to disclose *transmitting by the first device a second message to the second device, and the second device transmitting a second key of the second message to a third device*, Applicants respectfully request the Examiner reconsider and withdraw the Examiner's rejection of claim 21 under 35 U.S.C. §102. Claims 22-23 and 25 depend on and incorporate the patentable subject matter of independent claim 21. Thus, claims 22-23 and 25 are not anticipated by Ross. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the Examiner's rejection of claims 22-23 and 25 under 35 U.S.C. §102.

**Claim Rejections Under 35 U.S.C. §103****IV. Claim 24 Rejected Under 35 U.S.C §103 As Unpatentable**

Claim 24 was rejected under 35 U.S.C. §103 as unpatentable over Ross in view of Schneier, Applied Cryptography,” 1196, p. 48 (“Schneier”). Claim 24 is dependent on and incorporates the patentable subject matter of independent claim 21. Applicants respectfully traverse this rejection and submit that Ross in view of Schneier fails to teach or suggest each and every element recited in claim 24.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Ross in view of Schneier does not teach or suggest *transmitting by the first device a second message to the second device, and the second device transmitting a second key of the second message to a third device*. As discussed above with respect to claim 21, Ross does not disclose *transmitting by the first device a second message to the second device, and the second device transmitting a second key of the second message to a third device*. The Examiner cites Schneier only to suggest one ordinarily skilled in the art might modify Ross to encrypt the second key by a public key. Schneier does not teach or suggest *transmitting by the first device a second message to the second device, and the second device transmitting a second key of the second message to a third device*. Therefore, Ross in view of Schneier does not teach or suggest *transmitting by the first device a second message to the second device, and the second device transmitting a second key of the second message to a third device*.

Because Ross in view of Schneier fails to disclose, teach, or suggest *transmitting by the first device a second message to the second device, and the second device transmitting a second key of the second message to a third device*, Applicants submit that claim 24 is patentable and in condition for allowance. Therefore, Applicants request the Examiner to reconsider and withdraw the Examiner’s rejection of claim 24 under 35 U.S.C. §103.

**CONCLUSION**

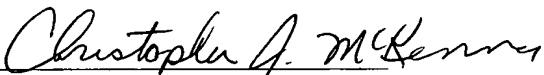
In light of the aforementioned arguments, Applicants contend that each of the Examiners' rejections has been adequately addressed and all of the pending claims are in condition for allowance. Accordingly, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection, and allowance of all of the pending claims.

Should the Examiner feel that a telephone conference with Applicants' attorney would expedite prosecution of this application, the Examiner is urged to contact the Applicants' attorney at the telephone number identified below.

Respectfully submitted,

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